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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,910	09/18/2003	Kazue Kudo	16869G-087100US	7077

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EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,910

Applicant(s)

KUDO ET AL.

Examiner

Kevin M Bernatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3,4 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 3,4 and 8-11 is/are objected to.
- 8) ☒ Claim(s) 1 and 3-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Response to Amendment

1. Amendments to claims 1, 3 and 5, cancellation of claim 2, and addition of new claims 6 - 11, filed on November 29, 2004 and March 7, 2005, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. Applicant's election without traverse of Group II, claims 3, 4 and 8 - 11 in the paper filed March 7, 2005 is acknowledged. Claims 1 and 5 - 7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

4. Claims 3, 4 and 8 - 11 are objected to because of the following informalities: claim 3 requires subject matter from a withdrawn claim. This objection can be overcome by including the subject matter of withdrawn claim 1 into claim 3. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3, 4 and 8 – 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 requires subject matter from a non-pending claim, which would render the claim indefinite upon claim 3 being indicated as allowable, since the withdrawn claim would be cancelled from the pending application. As such, applicants are required to incorporate the subject matter of the withdrawn claim into claim 3 to avoid claim 3 requiring the subject matter from a non-pending claim. For purposes of evaluating the prior art, the Examiner has interpreted claim 3 as including the subject matter of claim 1.

Claim Rejections - 35 USC § 103

7. Claims 3, 4 and 8 – 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohashi et al. (U.S. Patent No. 6,507,464) in view of Chen et al. (U.S. Patent No. 6,776,891).

Regarding claims 3 and 4, these claims are rejected for the reasons of record as set forth in Paragraph No.'s 4 – 11 of the Office Action mailed on September 7, 2004. Regarding the amended limitation regarding the thickness of the magnetic layer, the Examiner notes that Ohashi et al. disclose thickness values meeting applicants' claimed

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range (col. 4, lines 16 – 21; wherein the Examiner notes the overlap is in the range of 3 – 5 μm).

Regarding newly added claim 8 - 11, the Examiner notes that Ohashi et al. disclose a thin film head meeting applicants' claimed structural limitations (*Figure 1, elements 1 – 3 and col. 3, lines 47 – 67*).

Response to Arguments

8. The rejection of claims 3, 4 and 8 - 11 under 35 U.S.C § 103(a) – Ohashi et al. in view of Chen et al.

Applicant(s) argue(s) that neither Ohashi et al. nor Chen et al. disclose the requisite thickness range (*page 4 of response*), nor the requisite pH of the plating bath (*page 5 of response*). The examiner respectfully disagrees.

The Examiner notes that while Ohashi et al. disclose *preferred* embodiments outside applicants' claimed thickness range, a reference is good not only for the preferred embodiments, but the entire teaching. As such, Ohashi et al. disclose thickness values overlapping applicants' claimed thickness range as noted in the rejection of record. Regarding the pH, the Examiner notes that Chen et al. teaches overlapping end points with applicants' claimed range, which is a *prima facie* case of obviousness.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

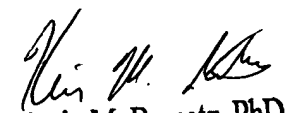
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
May 25, 2005


Kevin M. Bernatz, PhD
Primary Examiner